REMARKS

This Amendment is submitted in full response to the Office Action dated April 21, 2005, on the merits of the above-identified case and, a check in the amount of $225.00 for newly added claims is enclosed herewith. Accordingly, re-consideration of this application is hereby respectfully requested.

In the outstanding Office Action, all of the claims stand rejected. Specifically, claims 1-13, 32-41, and 43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Bekker; claims 1, 7, 13-16, 19-21, and 30-31 stand rejected under 35 U.S.C. §102(b) as being anticipated by Garate; and, claims 19, 22-23, and 25-29 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lee. In addition, claim 42 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Bekker in view of Plost et al.; claims 17-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Garate; and, claims 19 and 22-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Campbell in view of Smith.

Applicant is appreciative of the Examiner's detailed and conscientious review of this application, and respectfully asks for his conscientious reconsideration of same, in light of the amended and new claims presented herein, and the following remarks.

A. Issues Raised by Section 102 and Section 103 Rejections.

Before reviewing the substantive issues with regard to the

rejection of the claims, the Applicant respectfully points out the well established requirement that:

> For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference. Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

Moreover, this burden on the U.S. Patent and Trademark Office ("PTO") is further compounded by the fact that the Federal Circuit has stated that within the single reference:

> [t]he identical invention must be shown in as complete detail as is contained in the patent claim. Richardson v. Suzuki Motor Co. Ltd., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

And, more recently, the Federal Circuit has further expanded this principle to include that:

> An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002).

As such, if an Applicant can establish that at least one claimed element is not present or is not identically disclosed in as complete detail in a prior art reference put forth by the PTO, the grounds for rejection pursuant to 35 U.S.C. §102 of each claim comprising that element have been overcome. Furthermore, once the grounds for rejection under 35 U.S.C. §102 have been overcome, the PTO cannot merely turn to 35 U.S.C. §103 as a basis for maintaining a rejection without first meeting the requisite burden. Specifically, the decisions of the Federal Circuit instruct that:

> In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facia case of obviousness based upon the prior art [and further that] the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Recently, this point was further emphasized by the Federal Circuit, which added that:

> To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the [Examiner] to show a motivation to combine the references that create the case of obviousness. In other words, the [Examiner] must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.
>
> This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. Beckson Marine, Inc. v. NFM, Inc., 292 F.3d 718, 63 USPQ2d 1031, 1037 (Fed. Cir. 2002); citing In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

B. Amended Claims.

In view of the foregoing, the Applicant has amended each of the original independent claims, all of which are now believed to be in condition for immediate allowance and, as such, all of the claims depending therefrom, either directly or indirectly, are also now believed to be in condition for immediate allowance.

To begin, the Examiner's has characterized U.S. Patent No. 6,799,528 issued to Bekker as disclosing the Applicant's invention stating, in part, that "inherently . . . [the] thrust axes will be

parallel to the centerline of the craft," while further, and correctly, acknowledging that the preferred embodiment of Bekker requires dynamic positioning, i.e., the thrust axes being independently and continuously repositioned such that the thrust axes are specifically not maintained parallel to the centerline of the craft. Specifically, while each of the thrust axes of the Bekker device may be aligned parallel with the centerline of the craft, Bekker is specifically structured to continuously realign each thrust axis out of such parallel alignment as necessary to maintain the vessel at a fixed coordinate, and Bekker does not include any structure to dispose and continuously maintain the thrust axes substantially parallel with the centerline of the vessel.

Conversely, the present invention encompasses outboard trolling motors structured to generate thrust along a corresponding thrust axis, wherein each thrust axis is disposed and continuously maintained substantially parallel to a longitudinal centerline of a boat to assure maximum operating efficiency of the trolling motors. In addition, the present invention comprises a deployment assembly which, as illustrated in the drawings, includes positionable mounting members structured to operatively engage a corresponding trolling motor and to position the motor into at least one predetermined deployed position. The specification of the present application, beginning on page 15, line 24, further provides that:

> [i]n this predetermined deployed position, the thrust axis 17 of the outboard trolling motor 14 is disposed and

> maintained substantially parallel to the longitudinal centerline of the boat, thus allowing the maximum efficiency to be obtained from the outboard trolling motor 14.

Thus, the structure of the deployment assembly of the present invention assures that the thrust axes of the trolling motors operatively engaged thereby are disposed and continuously maintained substantially parallel to the longitudinal centerline of the boat. More in particular, the positionable mounting members of the deployment assembly of the present invention assure that the thrust axes of the trolling motors operatively engaged thereby are disposed and continuously maintained substantially parallel to the longitudinal centerline of the boat.

In view of the foregoing, the Applicant has amended each of the original independent claims, namely, claims 1, 19, 32, and 43, to specifically recite that each thrust axis is "disposed and continuously maintained substantially parallel to the longitudinal centerline of the boat." Therefore, the Applicant submits that these claims are not anticipated by Bekker, nor by any other reference cited by the Examiner under 35 U.S.C. §102, namely, U.S. Patent No. 3,250,239 issued to Garate and U.S. Patent No. 5,131,875 issued to Lee, as they also fail to disclose <u>any</u> structure such that the thrust axes are "disposed and continuously maintained substantially parallel to the longitudinal centerline of the boat," as disclosed and claimed in the present invention.

Thus, the Applicant has established that at least one claimed element is not present or is not identically disclosed in as

complete detail by either Bekker, Garate, or Lee, and, as such, the Applicant respectfully asserts that each of the grounds for rejection under 35 U.S.C. §102 have been overcome. Further, in view of the aforementioned claim amendments, the Applicant respectfully asserts that the grounds for rejection under 35 U.S.C. §103 based upon either Bekker in view of Plost et al. or Garate have also now been overcome. Finally, the Applicant has further amended independent claim 19 to specifically recite the "outboard trolling motors disposed laterally outward from an opposite side of a stern of the boat," and, as such, the Applicant respectfully asserts that grounds for rejection under 35 U.S.C. §103 based upon Campbell in view of Smith has been overcome.

Therefore, the Applicant maintains that each of the original independent claims as amended herein are clearly in condition for immediate allowance, and reconsideration by the Examiner is respectfully requested. Further, all of the claims depending from the original independent claims as amended herein, either directly or indirectly, are now also believed to be in condition for immediate allowance. Finally, the Applicant notes that several of the dependant claims have been amended herein to assure proper antecedent basis and to conform with the underlying independent claims, as amended herein.

B. New Claims 44 through 46.

The Applicant further submits that new independent claims 44

and 45, each of which recites an embodiment of the present invention having each thrust axis "disposed and continuously maintained substantially parallel to the longitudinal centerline of the boat," are not anticipated by Bekker, Garate, or Lee for the reasons stated above, and are, therefore, in condition for immediate allowance.

In addition, the Applicant submits that new dependent claim 45, which depends directly from independent claim 1, as amended herein, and which further recites the "thrust axis being disposed and continuously maintained in said substantially parallel disposition to the longitudinal centerline of the boat by said positionable mounting member" is, therefore, also believed to be in condition for immediate allowance.

The Applicant asserts that new claims 44 through 46 are fully supported by the disclosure of the specification of the present application, and do not contain any new matter.

Accordingly, based on the above Amendments and Remarks, the Examiner is respectfully requested to reconsider his position with regard to the present application. Since nowhere in the art is this new, novel and non-obvious invention found, taught, or suggested, it is urged that this case is now clearly in condition for allowance and, accordingly, such action is respectfully solicited.

In the event that any fee may be required by the filing of this paper, an Authorization to Charge Fees to Deposit Account,

Deposit Account No. 13-1227, is being filed concurrently with this Amendment.

Respectfully submitted,

MALLOY & MALLOY, P.A.
Attorneys for Applicant
2800 S.W. Third Avenue
Historic Coral Way
Miami, Florida 33129
(305) 858-8000

By: John Fulton
John Fulton, Jr.
Reg. No. 46,716

Dated: 7-18-05